

REMARKS

This paper responds to the Office Action dated July 7, 2010. Claims 30, 35, 38, 40, 46, and 51-53 are presently amended. Claims 1-29 were previously canceled, and no claims are presently added. As a result, claims 30-53 remain pending in this application.

Claim Amendments

Claims 30, 35, 38, 40, 46, and 51-53 are presently amended for purposes of clarity. The claim amendments implement suggestions for clarification discussed in the telephone interview held on August 19, 2010. Applicants aver that no new matter has been added. Subject matter support for the claim amendments is found, for example, at least in the claims as recited prior to amendment herein,¹ as well as in Applicants' originally filed specification.²

Double Patenting Rejection

Claims 1, 8, and 9 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over copending application 10/614,765 ("Kocher(2)") in view of Herzberg et al. (EP 0717337, "Herzberg"). Applicants note the provisional nature of these rejections and will consider filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b)(iv) should the copending application issue prior to issuance of the instant claims herein, to obviate these rejections. Applicants do not admit that any claims are obvious over the copending application in view of Herzberg.

The Rejection of Claims Under § 101

Claim 52 was rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. Specifically, with respect to the phrase "machine-readable storage medium," the Office Action stated that "the term 'medium' . . . includes a transitory signal."³ Claim 52 is amended herein to recite, in part, "[a] **non-transitory machine-readable storage medium.**"

¹ See, e.g., claims 31, 41-42, and 44, prior to amendment herein.

² See, e.g., paragraphs 0036-0037, 0045, 0093-0094, 0135, 0137, and 0143-0150 of Applicants' published application (U.S. Patent Application Publication 2007/0033419).

³ Office Action at 5.

According to instructions issued by the USPTO, “[a] claim drawn to such a computer readable medium . . . may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘**non-transitory**’ to the claim.”⁴ The USPTO has instructed that, “[s]uch an amendment would typically not raise the issue of new matter.”⁵ Applicants respectfully submit that, as amended herein, claim 52 does not encompass nonstatutory subject matter. Thus, Applicants respectfully request that this rejection be reconsidered and withdrawn and that the claim be allowed.

The Rejection of Claims Under § 103

Claims 30-39 and 53 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Herzberg in view of Suzuki et al. (EP 0982725, “Suzuki”). A determination of obviousness requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”⁶ “The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, . . . secondary considerations.”⁷ “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.”⁸ Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements.

Each of independent claims 30, 35, 38, and 53 is amended herein to recite, in part, “**first data processing instructions [] specific to the digital content and [] executable by a computer language interpreter of the playback device to authenticate the second data processing**

⁴ USPTO Notice, “Subject Matter Eligibility of Computer Readable Media,” issued January 26, 2010, emphasis added.

⁵ *Id.*

⁶ *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

⁷ *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467, *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406-7, 82 U.S.P.Q.2d 1385, 1390 (2007), cited in *Ex parte Frye*, Appeal No. 2009-006013 (BPAI 2010) (precedential).

⁸ *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970), emphasis added; see MPEP § 2143.03.

instructions.”⁹ The Office Action cited to column 6, lines 46-52 of Herzberg as allegedly teaching these “first data processing instructions.”¹⁰ The cited passage of Herzberg, however, merely discusses “data objects . . . [being] read from the CD-ROM . . . [and] a multimedia title contain[ing] about 650 megabytes of data.”¹¹ Mere discussion of data objects or megabytes of data makes no mention of data processing instructions that are specific to the digital content and that are executable to authenticate further data processing instructions. The entirety of Herzberg does not mention this claim element, and the Office Action cited no other reference in discussing this claim element. Suzuki is similarly silent with respect to this claim element. As a result, at least this claim element is absent from the combination of Herzberg and Suzuki.

Moreover, each of independent claims 30, 35, 38, and 53 is amended herein to recite, in part, “**second data processing instructions being executable** by the computer language interpreter of the playback device **to request an access to [a] memory of the playback device.”**¹² The Office Actions cited to column 1, lines 50-55 of Herzberg as allegedly teaching these “second data processing instructions.”¹³ The cited passage of Herzberg, however, merely states that a “validation structure is embedded in the multimedia program and in response to an initiation of the multimedia program, a determination is made as to whether the multimedia program is an authorized multimedia program.”¹⁴ Mere discussion of a validation structure makes no mention of data processing instructions. Moreover, a determination as to whether a multimedia program is authorized has nothing to do with data processing instructions that are executable to request an access to a memory of a playback device. The entirety of Herzberg does not mention this claim element, and the Office Action cited no other reference in discussing this claim element. Suzuki is similarly silent with respect to this claim element. As a result, at least this claim element is absent from the combination of Herzberg and Suzuki.

⁹ Emphasis added.

¹⁰ Office Action at 6.

¹¹ Herzberg at column 6, lines 46-52.

¹² Emphasis added.

¹³ Office Action at 6.

¹⁴ Herzberg at column 1, lines 51-55.

For at least these reasons, the scope and content of Herzberg and Suzuki, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 30, 35, 38, and 53, and their respective dependent claims 31-34, 36-37, and 39. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

Claims 40-52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kocher et al. (U.S. Patent 6,289, 455, “Kocher”) in view of Suzuki. Applicants respectfully traverse these rejections.

Each of independent claims 40, 46, and 51-52 is amended herein to recite, in part, “**first data processing instructions . . . specific to the digital content and . . . executable by the [computer language interpreter] of the [playback device] to identify second data processing instructions that are executable by the [playback device] to affect playback of the digital content.**”¹⁵ The Office Actions cited to column 9, lines 15-20 of Kocher as allegedly teaching these “first data processing instructions.”¹⁶ The cited passage of Kocher, however, merely discusses “Key Distribution Messages . . . and Rights Enablement Messages . . . [being] distributed with content.”¹⁷ Mere discussion of messages makes no mention of data processing instructions that are specific to the digital content and that are executable to identify further data processing instructions that are executable to affect playback of the digital content. The entirety of Kocher does not mention this claim element, and the Office Action cited no other reference in discussing this claim element. Suzuki is similarly silent with respect to this claim element. As a result, at least this claim element is absent from the combination of Kocher and Suzuki.

¹⁵ Emphasis added.

¹⁶ Office Action at 12 and 16.

¹⁷ Kocher at paragraph 9, lines 18-20.

For at least these reasons, the scope and content of Kocher and Suzuki, even if combined, do not teach or suggest all claimed elements or support rational inferences that one skilled in the art reasonably would be expected to draw to reach all claimed elements. As a result, a determination of obviousness is not established with respect to any of independent claims 40, 46, and 51-52, and their respective dependent claims 41-45 and 46-50. Moreover, the dependent claims may each be patentable based on limitations recited therein. Thus, Applicants respectfully request that these rejections be reconsidered and withdrawn and that the claims be allowed.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4048 to facilitate prosecution of this application.

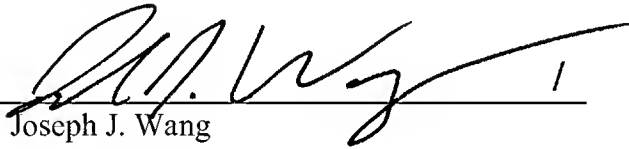
If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date September 22, 2010

By 1


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22nd day of September, 2010.

Kathryn Grinnell
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Signature